

REMARKS

Claims 21-39 currently remain the same, while Applicant is presenting new claim 40 herein. New claim 40 corresponds to claim 15 previously presented in the preliminary amendment filed on December 21, 2004. Accordingly, Applicant asserts no subject matter has been relinquished by these amendments. Additionally, these amendments do not introduce new matter within the meaning of 35 U.S.C. §132

1. Specification

The Office Action states,

(1) Applicant's arguments, see page 2, paragraphs 1-4, filed 12/4/2006, with respect to previous claims 11 and new claim 31 have been fully considered and are persuasive. The rejection of claims 11 and 31 has been withdrawn. However, examiner request applicants to amend the specification (to 1-19 carbons from 1-16 carbons) to reflect this change in the claims.

RESPONSE

Applicant kindly thanks the Examiner for withdrawing the previous rejection to previously pending claim 11, which corresponds to currently pending claim 31. As requested, Applicant has submitted a substitute specification herein that complies with 37 CFR §1.125. Accordingly, a marked-up copy of the specification is submitted herein as ATTACHMENT B, and a clean copy of the specification is submitted herein as ATTACHMENT C.

The substitute specification does not introduce new matter

within the meaning of 35 U.S.C. §132.

2. Supplemental Information Disclosure Statement

Applicant filed a Supplemental Information Disclosure Statement on November 30, 2006. Accordingly, Applicant respectfully requests the Examiner to review and acknowledge the documents cited therein, and initial and return to Applicant a copy of the PTO-1449 form previously submitted.

3. Rejection of Claims 1-20 Under 35 U.S.C. §103(a)

The Office Action states,

(5) Applicants argue that Bohnen I was commonly owned at the time of the invention and therefore Bohnen I is not prior art under 35 USC 103(c). This argument is not persuasive because Bohnen qualifies as a 102(e) and therefore, is not disqualified as prior art under 35 USC 103(c).

RESPONSE

Applicant respectfully traverses the current rejection.

In particular, as outlined on page 4, lines 1-8, in the previous Office Action with a mailing date of June 15, 2006, the Office Action stated,

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bohnen et al., USP 6,482,902 (hereafter referred to as Bohnen I) in view of Bohnen, USP 6,417,302 (hereafter referred to as Bohnen II).

Bohnен I discloses the invention substantially as claimed when one considers that the combination of the active hydrogen-containing group (C) of the present claims plus the organometallic compound (B) of the present claims

corresponds to the ingredient d) of col. 2, l. 35-54 and examples 1-4 of the prior art (col. 2, l. 14 to col. 3, l. 16; col. 3, l. 41 to col. 5, l. 31; examples 1-4, 6, 8, 11, 13, 17-25). (Emphasis added)

Accordingly, in Applicant's response of November 30, 2006, on page 9, lines 19-28, Applicant responded by stating,

Notwithstanding, the current application and the subject matter contained in U.S. Patent 6,482,902 (referred to herein as Bohnen, et al. I) is commonly owned, and Applicant was subject to an obligation of assignment to the owner of Bohnen, et al. I at the time the claimed inventive subject matter was made. Applicant has included herein as Attachment B (1) a copy of the Recordation of Assignment for the currently pending application, and (2) a copy of the assignee of record for Bohnen, et al. I from the U.S. Assignment database. Accordingly, Applicant respectfully believes Bohnen, et al. I is not prior art under 35 U.S.C. 103(c).

In rebuttal to Applicant's response, the current Office Action states,

(5) Applicants argue that Bohnen I was commonly owned at the time of the invention and therefore Bohnen I is not prior art under 35 USC 103(c). This argument is not persuasive because Bohnen qualifies as a 102(e) and therefore, is not disqualified as prior art under 35 USC 103(c).

However, it is unclear to Applicant what the Examiner is referring to as the basis of the current rejection.

In particular, it is unclear to Applicant as to whether the Examiner is maintaining the previous 35 U.S.C. §103(a) rejection, which was outlined on page 4, lines 1-8, in the previous Office Action having a mailing date of June 15, 2006, or if the Examiner has now issued a new rejection, now rejecting Applicant under 35

U.S.C. 102(e) in view of U.S. Patent 6,482,902 (referred to herein as "the '902 patent").

If the Examiner is maintaining the previous obviousness rejection under 35 U.S.C. §103(a) in which the '902 patent is being used under 35 U.S.C. 102(e) as the basis for the 35 U.S.C. 103(a) rejection, then Applicant respectfully maintains and asserts that the '902 patent cannot be used in a 35 U.S.C. 103(a) rejection based on Applicant's assertion outlined in Applicant's response of November 30, 2006, and 35 U.S.C. 103(c). See MPEP §2146 and §706.02(l)(1).

Accordingly, if the above is true, Applicant respectfully requests the Examiner to withdraw the current rejection.

However, if the Examiner is now issuing a new rejection based on anticipation to the '902 patent under 35 U.S.C. 102(e), Applicant respectfully traverses this rejection based on the Examiner's acknowledgment in the previous Office Action, on page 4, lines 9-10,

Bohnen I lacks disclosure of combining the all the reagents simultaneously without isolation of intermediates, i.e. a 'one-pot' synthesis.

For a reference to anticipate an invention, all of the elements of that invention must be present in the reference. The test for anticipation under section 102 is whether each and every element as set forth in the claims is found, either expressly or inherently, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical

invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must also be arranged as required by the claim. *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990).

Accordingly, if the above is true, Applicant respectfully requests the Examiner to withdraw the current rejection.

Additionally, if the Examiner is now issuing a new ground for rejection (i.e., anticipation under 35 U.S.C. 102(e)), which was not outlined in the previous Office Action, Applicant respectfully traverses the finality of the currently pending Office Action. "Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)." Given the amendments previously submitted with Applicant's response of November 30, 2006 were to fix an obvious typographical error, obviate the Examiner's objections, and for informal reasons, Applicant respectfully believes the amendments did not necessitate the current Office Action to be final. See MPEP §706.07(a).

Accordingly, if prosecution is not closed for this application in light of this response, Applicant respectfully requests the Examiner to withdraw the finality of the current Office Action.

In light of the above, Applicant kindly requests the Examiner

to withdrawal this rejection.

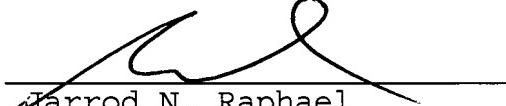
CONCLUSION

Based upon the above remarks, the presently claimed subject matter is believed to be novel and patentably distinguishable over the references of record. The Examiner is therefore respectfully requested to reconsider and withdraw the currently pending rejection, and allow claims 21-40. Favorable action with an early allowance of the claims pending in this application is earnestly solicited.

The Examiner is welcomed to telephone the undersigned practitioner if he has any questions or comments.

Respectfully submitted,

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RCE I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450 on

August 3 2007

Allyn A. Dutton
Signature

Date

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